

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID W. CONWAY

Appeal No. 2002-0502
Application 08/853,425

ON BRIEF

Before OWENS, DELMENDO and JEFFREY T. SMITH, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the nonfinal third rejection of claims 1-22, which are all of the claims in the application.¹

¹Because the claims have been twice rejected, the board has jurisdiction as discussed in *Ex parte Lemoine*, 46 USPQ2d 1432 (Bd. Pat. App. & Int. 1995).

THE INVENTION

The appellant's claimed invention is directed toward an absorbent barrier sheet and a method for making it. Claim 8, which claims the absorbent barrier sheet, is illustrative:

8. An absorbent barrier sheet comprising:

an integral fabric web having a generally hydrophobic upper portion at the top of the sheet, the fabric web having a lower fluid-retaining portion in wicking communication with the upper portion whereby the top of the sheet tends towards dry, the lower fluid-retaining portion including a lower surface; and

a barrier material intimately connected to substantially the entire lower surface of the fabric web lower portion whereby the bottom of the sheet tends to be dry.

THE REFERENCES

Whyte	3,881,491	May 6, 1975
Korpman	4,886,511	Dec. 12, 1989
Heiman	5,290,269	Mar. 1, 1994
Osborn, III	5,383,869	Jan. 24, 1995

THE REJECTIONS

Claims 1-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Heiman in view of Osborn, Korpman or Whyte.

OPINION

We reverse the aforementioned rejections. We need to address only claim 8, which is the broadest claim to an absorbent barrier sheet.²

Rejection over Heiman in view of Osborn

Heiman discloses an absorbent barrier sheet comprising an integral fabric having a hydrophobic upper portion which tends toward dry, a lower fluid-retaining portion in wicking communication with the upper portion, and a barrier sheet, which tends to be dry, below the lower fluid-retaining portion (col. 7, lines 21-27; col. 9, line 63 - col. 10, line 18; col. 11, lines 27-45; col. 13, line 59 - col. 14, line 4). The appellant acknowledges that the appellant's integral fabric web is the same as that of Heiman (specification, page 6, lines 3-9; brief, page 6). Heiman's absorbent barrier sheet differs from that of the appellant in that Heiman's barrier sheet is not intimately connected to substantially the entire lower surface of the fabric web lower portion. Instead, Heiman's integral fabric web and barrier sheet are held together by overcast stitching or the

² Claim 18, which is the broadest claim to a method for forming an absorbent barrier sheet, is of comparable scope to claim 8.

like, or by tape around their peripheral edges which is held in place by stitching (col. 10, lines 26-48).³

Osborn discloses a sanitary napkin comprising an absorbent means (13) which includes an absorbent core (34) between a liquid permeable topsheet (25) and a liquid impermeable barrier sheet (16) (col. 3, line 51 - col. 4, line 5). The absorbent core preferably is made of hydrogel-forming material (col. 4, lines 6-7). Osborn teaches (col. 4, lines 41-49):

The absorbent core **34** may be attached over the core's first or second major surfaces **46** and **49**, respectively, to adjacent members such as the topsheet **25** and barrier sheet **16** by any of the means well known in the art, such as by spray-gluing or lines or spots of adhesive. Such attachment facilitates integrity and recoverability of the absorbent materials in use so as to maintain an optimum degree of absorbency.

The examiner argues that one of ordinary skill in the art would have been led by Osborn to use an adhesive to attach Heiman's integral fabric web to the barrier sheet to facilitate integrity of the absorbent barrier sheet and to reduce cost by eliminating Heiman's expensive binding and/or stitching

³ The appellant's barrier material is intimately connected to the integral fabric web by extrusion coating or laminating the barrier material onto the lower fluid-retaining portion of the integral fabric web (specification, page 7, lines 6-17).

operations (answer, page 5).⁴ Improved integrity, the examiner argues, would prevent bunching up, which Heiman indicates is undesirable (answer, pages 3 and 5).⁵

In order for a *prima facie* case of obviousness of the appellant's claimed invention to be established, the prior art must be such that it would have provided one of ordinary skill in the art with both a suggestion to carry out the appellant's claimed invention and a reasonable expectation of success in doing so. See *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id.* The mere possibility that the prior art could be modified such that the appellant's process is carried out is not a sufficient basis for a *prima facie* case of obviousness. See *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Ochiai*, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1131 (Fed. Cir. 1995).

⁴ We have renumbered the pages of the examiner's answer consecutively.

⁵ Heiman prevents bunching up by use of a stiffener sheet (col. 19, lines 1-20 and 40-48).

Heiman uses a flexible stiffener sheet (40) to prevent or minimize bunching (col. 19, lines 1-3 and 12-20). The examiner has not established that Heiman and Osborn themselves would have motivated one of ordinary skill in the art to use Osborn's adhesive instead of Heiman's stiffener sheet. Also, Heiman's absorbent barrier sheet is for a washable, reusable incontinent pad (col. 14, lines 63-66), whereas Osborn's absorbent article is not intended to be laundered but, rather, is to be discarded after a single use (col. 3, lines 42-45). The examiner has not established that one of ordinary skill in the art would have had a reasonable expectation that Osborn's adhesive would be suitable in laundered article.

Moreover, the purpose of Heiman's binding strip referred to by the examiner (answer, page 3) is not only to hold layers 22 and 25 of an incontinent pad together, but to define the rounded corners of the pad (col. 10, lines 26-46). The examiner has not established that the applied references would have motivated one of ordinary skill in the art to substitute adhesive for Heiman's binding tape and thereby forgo Heiman's desired rounded corners. Heiman's layers 22 and 25 also can be held together by overcast stitching or the like (col. 10, lines 47-48). The examiner, however, has not established that Osborn's teaching regarding

using adhesive to hold layers together in a single-use, disposable article would have provided one of ordinary skill in the art with a reasonable expectation of success in using the adhesive to hold together layers of a washable, reusable article.

For the above reasons we conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the appellant's claimed invention over the combined teachings of Heiman and Osborn.

Rejection over Heiman in view of Korpman

Korpman discloses a corrugated disposable diaper having elastic strings between a fibrous batt and a liquid-impermeable film, wherein the film has been applied in molten form by extrusion (col. 2, lines 35-64; col. 3, lines 43-44; col. 4, lines 16-18).

The examiner argues that it would have been obvious to one of ordinary skill in the art to apply Heiman's liquid-impervious layer (22) by Korpman's extrusion method to reduce cost by eliminating Heiman's expensive binding and/or stitching step for holding liquid-impervious layer 22 and liquid-absorbing layer 25 together (col. 10, lines 21-48). As discussed above regarding the rejection over Heiman in view of Osborn, however, the examiner has not established that the applied references would

have 1) motivated one of ordinary skill in the art to forgo Heiman's rounded corners produced by Heiman's binding method, and 2) provided one of ordinary skill in the art with a reasonable expectation of success in using Korpman's extruded film, which is part of a disposable diaper, in Heiman's washable, reusable article.

Accordingly, we conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the appellant's claimed invention over Heiman in view of Korpman.

Rejection over Heiman in view of Whyte

Whyte discloses a self-inflating structure which can be combined with an absorbent pad to form a disposable diaper or a bed pad (col. 1, lines 4-8; col. 5, lines 25-34; col. 6, lines 40-67). The structure includes a plain lamina (22) and an embossed lamina (23) which are secured together by fusing or thermowelding to form collapsed, inflatable pillows (21) (col. 2, lines 47-65). An absorbent pad is secured to the embossed lamina (col. 8, lines 4-5).

The examiner argues that Whyte is relied upon for lack of a teaching of binding tape and/or edge stitching, and that without a disclosed method of attaching the absorbent pad to the embossed lamina, one of ordinary skill in the art would have had to look

to well known methods of attachment such as adhesive, fusion, thermal bonding or extrusion (answer, page 9). The examiner argues that one of ordinary skill in the art, having selected those methods of attachment of Whyte's absorbent pad to the embossed lamina, would have used the methods to attach Heiman's liquid-absorbing layer to the liquid-impervious layer to reduce cost by eliminating Heiman's expensive binding and/or stitching step (answer, page 5). The examiner, however, has not explained why one of ordinary skill in the art would have been led by the applied references to select adhesive, fusion, thermal bonding or extrusion to attach Whyte's absorbent pad to the embossed lamina, let alone to make that selection and then use that method to bond Heiman's liquid-absorbing layer to the liquid-impervious layer. The record indicates that the motivation relied upon by the examiner for making these selections comes from the appellant's disclosure of his invention rather than coming from the applied prior art and that, therefore, the examiner used impermissible hindsight when rejecting the claims. *See W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Hence, the

Appeal No. 2002-0502
Application 08/853,425

examiner has not established a *prima facie* case of obviousness of the appellant's claimed invention over Heiman in view of Whyte.

DECISION

The rejections of claims 1-22 under 35 U.S.C. § 103 over Heiman in view of Osborn, Korpman or Whyte are reversed.

REVERSED

TERRY J. OWENS)	
Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
ROMULO H. DELMENDO)	
Administrative Patent Judge)	APPEALS AND
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Appeal No. 2002-0502
Application 08/853,425

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